

REMARKS

Claims 1 through 10, 14, 16, 17, and 20 through 26 are pending in this Application. Claims 15, 18, and 19 have been cancelled without prejudice or disclaimer. Claims 1, 3, 4, 9, 10, 14, 16, and 17 have been amended, and new claims 20 through 26 have been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the Abstract, FIGs. 2 and 3, ¶¶[0018], [0019], [0022], [0025], [0037], [0040], [0045], [0060], [0063] through [0066], [0071], [0072], [0074], and [0081] of the corresponding US Pub. No. 20060154710. Applicant submits that the present Amendment does not generate any new matter issue.

(1) Claims 1, 2, 6, 7, 9 through 11, 14, 15, 17, and 18 were rejected under 35 U.S.C. §102(b) as being anticipated by a publication entitled “Unreal Tournament 2003 Game Manual” (“*Game Manual*”), “as evidenced by” an online article available at <http://theadminpage.planetunreal.gamespv.com/Non-DedicatedLAN.htm> by MutantKiller entitled “The Cable/DSL/T1 Server” (as extrinsic evidence).

In stating the rejection, the Examiner asserted that *Game Manual* discloses all elements of the claimed inventions. Applicant respectfully traverses this rejection.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown*

Operations International Ltd. v. Solutia Inc., 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Moreover, when imposing a rejection under 35 U.S.C. §102 for lack of novelty, the Examiner is required to specifically identify where in the applied reference disclosed each and every feature of the claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Indeed, there are fundamental differences between the claimed inventions and *Game Manual* that scotch the factual determination that *Game Manual* discloses, or even remotely suggests, the identically claimed inventions.

Specifically, independent claims 1, 10, and 14 recite, *inter alia*: “continuing the game by the apparatus [of the first player] **as the first player and as the second player**, by at least simulating the participation of said second player who is actually absent (FIG. 2; ¶¶[0018], [0019], [0037], [0045], [0063], [0074])” that undermine the prior art rejection. These features are neither disclosed nor suggested by *Game Manual*. In stark contrast to the claimed inventions, it is a central game server in *Game Manual* (rather than an apparatus of a player) that simulates an absent player with a bot.

The above-argued fundamental and functionally significant differences between the claimed inventions and *Game Manual* undermine the factual determination that *Game Manual* identically discloses the claimed inventions as required under 35 U.S.C. §102(b). *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claims 1, 2, 6, 7, 9 through 11, 14, 15, 17, and 18

under 35 U.S.C. §102(b) for lack of novelty based on *Game Manual* is not factually viable, and hence, solicit withdrawal thereof.

(2) Claims 3 through 5 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Game Manual* in view of *Begis* (US 6024643, “*Begis*”).

(3) Claims 8 and 16 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Game Manual*.

Each of these rejections under 35 U.S.C. §103(a) is traversed.

Specifically, claims 3, 5, and 8 depend from independent claim 1, and claim 16 depends from independent claim 14. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 14 under 35 U.S.C. §102(b) for lack of novelty as evidenced by *Game Manual*. The secondary reference *Begis* and the Examiner’s additional comment regarding claims 8 and 16 do not cure the previously argued deficiencies of *Game Manual*. Accordingly, even if *Game Manual* is modified as proposed by the Examiner, and Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicant, therefore, submits that none of the above-identified imposed rejections under 35 U.S.C. §103(a) for obviousness predicated upon *Game Manual* in view of *Begis* is factually or legally viable and, hence, solicits withdrawal thereof.

New claims 20 through 26.

New claims 20 through 22 depend from claim 14; new claims 23 through 25 depend from claim 1; and new claim 26 depends from claim 10. Applicant submits that claims 20 through 26

are free of the applied prior art for reasons advocated *supra* with respect to claims 1, 10, and 14. Accordingly, claims 20 through 26 are free of the applied prior art.

Based upon the foregoing, it is apparent that the imposed rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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